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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/675,857

**Applicant(s)**

SAARINEN ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 75-133 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 75-133 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. The Applicants amendment filed on October 27, 2008 is hereby acknowledged, Claims 75- 133 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2008 has been entered.

### ***Response to Arguments***

3. The Applicant's arguments entered on October 27, 2008 have been fully considered. The Amended claims are rejected as being unpatentable over Lee (US Patent 2002/0111909) in view of Izumoto (US Patent Application Publication 2002/0004762).
- 4.

The Examiner states that the amended claims fail to overcome the rejection under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a

particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

The Examiner states that claim 75 remains rejected under 35 USC § 112 as being indefinite, the claim language discloses a ticket characteristic as including “other presentation data”, the Examiner submits that the claimed limitation still encompasses any conceivable property of the ticket (e.g. location, function, design etc...) and is therefore non-limiting and indefinite.

The Applicant states that the proposed combination does not teach or suggest a technique for receiving an active ticket in a mobile terminal for use by a mobile terminal user; and in response to a control signal, dynamically changing a ticket characteristic of the active ticket provided by the mobile terminal based on one or more states in a life cycle of the active ticket,

The Examiner replies that Lee discloses “FIG. 4 shows the flow chart of the software that implements the process of modifying the e-ticket information previously recorded on an IC card. At the start (step 110), a user connects to the ticket server 10 from which the user purchased the ticket but has not used yet. At step 112, the user indicates whether the user desires to either change the ticket, such as changing the departure date of a train ticket, or cancel the ticket. The ticket server then consult the e-ticket information recorded on the IC card at step 113. If the ticket server determines at step 114 that there is valid e-ticket information on the IC card, the ticket server 10

transmits at step 115 a ticket modification message to the user terminal 20, which either changes or cancels the e-ticket information at step 116.” (Paragraph 38)

The Examiner contends that the process of “either changes or cancels the e-ticket information” meets the claimed limitation of “dynamically changing a ticket characteristic of the active ticket”

### ***Claim Rejections - 35 USC §101***

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 75-115, 123,125,126 and 128-130 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim

positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 75 fails prong (1) because the “tie” (e.g. receiving in a mobile terminal) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

6. Claims 76- 115, 123,125,126 and 128-130 are either dependant upon claim 75 or contain a similar limitation and are rejected for at least the same reasons.

Claims 116-122 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claim 116 recites the term “module” which is “software per se” without any corresponding embodiment in a physical medium.

7. Claims 117- 122 are either dependant upon claim 116 or contain a similar limitation and are rejected for at least the same reasons.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 75-133 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 75 contains the term "ticket characteristic", the Examiner construes the term characteristic to mean "a distinguishing trait, quality, or property" the Examiner contends that the claimed limitation encompasses any conceivable property of the ticket (e.g. location, function, design etc...) and is therefore non-limiting and indefinite.

9. Claims 75 and 131 further contains the language "in response to a control signal" however there is no corresponding generation of any type of control signal
10. Claims 76-133 are either dependant upon claim 75 or contain a similar limitation and are rejected for at least the same reasons.
11. Claim 90 further contains the language "c.g.", this imposes no limitation upon the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 75-133 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Lee (US Patent 2002/0111909) in view of Izumoto (US Patent Application Publication 2002/0004762)
13. As per claim 75,  
Lee ('909) discloses a method comprising:

receiving an active ticket for use by a mobile terminal user; and  
in response to a control signal, dynamically changing a ticket characteristic of the active ticket provided based on one or more states in a life cycle of the active ticket where the ticket characteristic includes multimedia changes or other presentation data, including text, sound, animation, video, still pictures, or some combination thereof for verification by a ticket inspector. (Paragraphs 38-39 – Examiner notes that the language “includes multimedia changes or other presentation data, including text, sound, animation, video, still pictures, or some combination thereof for verification by a ticket inspector.” is representative of non-functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01)  
Lee ('909) does not explicitly disclose providing a mobile terminal. Izumoto ('762) discloses providing a host operating system (Figure 1, Abstract). It would be obvious to one having ordinary skill in the art at the time of the invention to combine Lee ('909) method with Izumoto ('762)'s teaching in order to allow a user to interact with the device.

14. As per claim 76,

Lee ('909) discloses A method according to claim 75, wherein dynamic changes to the ticket characteristic include multimedia changes or other presentation data, including text,



sound, animation, video, still pictures, or some combination thereof (Paragraph 39).

15. As per claim 77,

Lee ('909) discloses a method according to claim 75,  
wherein the one or more states in the life cycle include a state of being either purchased,  
validated, invalidated, template, pre-valid, prepared, or some combination thereof for one  
or more different events. (Paragraph 41-42)

16. As per claim 78,

Lee ('909) discloses a method according to claim 75,  
wherein the ticket characteristic dynamically changes based on a payment by the user of  
the mobile terminal. (Paragraphs 38-39)

17. As per claim 79,

Lee ('909) discloses a method according to claim 75,  
wherein the ticket characteristic dynamically changes based on a predetermined  
time, status or combination thereof. (Paragraphs 38-39)

18. As per claim 80,

Lee ('909) discloses a method according to claim 75,  
wherein the ticket characteristic dynamically changes based on a predetermined or

changing geographic location. (Paragraphs 38-39)

19. As per claim 81,

Lee ('909) discloses a method according to claim 75,

wherein the ticket characteristic dynamically changes based on a purchase transaction between a user of the mobile terminal and a ticket service provider.

(Paragraphs 38-39)

As per claim 82,

20. Lee ('909) discloses a method according to claim 75,

wherein a ticket service provider provides future ticket characteristic information to the mobile terminal that determines and/or activates the ticket characteristic.

(Paragraphs 38-39)

21. As per claim 83,

Lee ('909) discloses a method according to claim 75,

wherein the ticket characteristic information includes ticket characteristic control data, a ticket characteristic algorithm, a new set of ticket related media or a combination thereof. (Paragraphs 38-39)

22. As per claim 84,

Lee ('909) discloses a method according to claim 83,  
wherein the ticket characteristic control data includes new control data to change  
the ticket characteristic algorithm or other presentation data, including new parameter  
values.(Paragraphs 38-39)

23. As per claim 85,

Lee ('909) discloses a method according to claim 83,  
wherein the control data is received at a certain time or location, or just before  
the at least one active ticket is to be used. (Paragraphs 38-39)

24. As per claim 86,

Lee ('909) discloses a method according to claim 83,  
wherein the control data is sent to only purchased tickets based on a respective  
identification code associated with a respective mobile terminal. (Paragraphs 37-41)

25. As per claim 87,

Lee ('909) discloses a method according to claim 83,  
wherein the at least one active ticket is validated using visual or audio validation based  
on the ticket characteristic. (Paragraph 41)

26. As per claim 88,

Lee ('909) discloses a method according to claim 87,

wherein the visual or audio validation is performed by either a human, or a machine, or some combination thereof. (Paragraph 41)

27. As per claim 89,

Lee ('909) discloses a method according to claim 82,  
wherein the I ticket service provider provides the ticket characteristic information to the mobile terminal via the Internet or a mobile network. (Paragraph 38)

28. As per claim 90,

Lee ('909) discloses a method according to claim 82,  
Lee does not specifically disclose "the ticket service provider provides the ticket characteristic information to the mobile terminal using a Java-based protocol, e.g. MIDP Over-the-Air approach." Official Notice is taken that "the ticket service provider provides the ticket characteristic information to the mobile terminal using a Java-based protocol, e.g. MIDP Over-the-Air approach." is common and well known in prior art in reference to transaction protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide ticket characteristic information to the mobile terminal using a Java-based protocol in order to increase the compatibility of the system with a larger number of commercially available phones.

29. Claim 91 is in parallel with claim 90 and is rejected for at least the same reasons.

30. As per claims 92-94,

Lee ('909) discloses a method according to claim 1,

Lee does not specifically disclose "wherein the ticket characteristic is an audio ticket characteristic and the audio validation is based a relative frequency change" Official Notice is taken that "wherein the ticket characteristic is an audio ticket characteristic and the audio validation is based a relative frequency change as well as an audio watermark embedded therein using a secret key.." is common and well known in prior art in reference to transaction protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize an audible signal in conjunction with a watermark for ticket validation in order to prevent forging of the ticket.

31. As per claim 95,

Lee ('909) discloses a method according to claim 93,  
wherein the at least one active ticket is implemented using a protocol based on Mobile electronic Transactions (MET), including the MeT ticket format. (Paragraph 38  
[Examiner notes ticket is based on a specification for a transaction])

32. As per claim 96,

Lee ('909) discloses a method according to claim 95,  
wherein the MeT ticket format contains only a template for a pre-valid active ticket.  
(Paragraph 38)

33. As per claim 97,

Lee ('909) discloses a method according to claim 95,  
wherein the mobile transaction (MET) ticket format contains valid ticket information for  
a valid active ticket. (Paragraphs 35-37)

34. As per claim 98,

Lee ('909) discloses a method according to claim 97,  
wherein the valid ticket information is removed from the McT ticket for a used active  
ticket. (Paragraph 44)

35. As per claims 108-109,

Lee ('909) discloses a method according to claim 1,  
Lee does not specifically disclose “generating with a ticket issuer a root key, which can  
derive a number of seed keys;  
distributing the seed keys to users before issuing the active ticket; broadcasting a  
command encryption by the root key to indicate which of the seed keys can be used for  
decryption based on data managed by the ticket service provider; and  
allowing a user who is holding a valid seed key, which are allowed to decrypt the  
command package, to decrypt a command package and upgrade the ticket characteristic  
to a valid one.” Official Notice is taken that “generating with a ticket issuer a root key,  
which can derive a number of seed keys;

distributing the seed keys to users before issuing the active ticket; broadcasting a command encryption by the root key to indicate which of the seed keys can be used for decryption based on data managed by the ticket service provider; and allowing a user who is holding a valid seed key, which are allowed to decrypt the command package, to decrypt a command package and upgrade the ticket characteristic to a valid one..." is common and well known in prior art in reference to transaction protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize an encryption protocol in order to prevent forging of the ticket.

36. Claims 99-107, and 110 -133 are not patentably distinct from claims 75-98, contain the same claimed features and are rejected for at least the same reasons.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3685

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685